

REMARKS

In response to the Final Office Action mailed May 18, 2006 (hereinafter "Final Action"), no claims have been cancelled, amended, or newly added. Therefore, claims 1-25 remain pending. In view of the following comments, allowance of all the pending claims in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-25 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner alleges that the language of "*the list can be*" in claim 23 introduces ambiguity into the claims because it implies that the step may or may not be performed. See Final Action at 2. Similar language in claims 1, 8, 15, and 24 is also alleged as being indefinite for the same reason. See *id.* at 3. Applicant traverses this rejection for at least the reason that a person having ordinary skill in the art would be apprised of the metes and bounds of the claims, and because the claims meet the clarity and precision requirements of § 112, second paragraph.

Applicant disagrees with the Examiner's basis for alleging indefiniteness, as the language of "*the list can be*" and "*the list is able to be*" defines a property or characteristic of the list. This type of functional feature is not indefinite for at least the reason that a person having ordinary skill in the art would recognize this feature as defining a particular capability of the claimed list. The standards for evaluating definiteness prescribed in the MPEP indicate that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms." MPEP § 2173.05(g). "A functional limitation is often used in association with an element. . .to define a particular capability or purpose that is served by the recited element." *Id.* Thus, the Examiner's basis for indefiniteness is improper. Moreover, a person having ordinary skill in the art would be able to discern the boundaries of the claims. For at least these reasons, the rejection is improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0097361 to Huang *et al.* ("Huang") in view of "10 Minute Guide to Windows 3.1" to Barnes ("Barnes"), and further in view of Outlook 2000 & Outlook 97 screenshots ("Outlook"). Applicants traverse this rejection for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness. In particular, the combination of Huang, Barnes, and Outlook fails to disclose, teach, or suggest one or more features of the claimed invention.

With regard to claim 1, the combination of references relied upon by the Examiner fails to disclose, teach, or suggest at least the claimed feature of "creating the reusable list of selected entries and storing the reusable list in the system clipboard." In the Final Action, the Examiner alleges that this feature is taught by the combination of Outlook and Barnes, wherein it is alleged that "Outlook teaches the creation of a list by creating a copy of selected email document entries" and "Barnes teaches the copying of information using Windows system clipboard." See Final Action at 4. However, this combination fails to establish that the references teach the features of the claimed invention.

In particular, claim 1 recites that the reusable list of entries "includes document summary data pertaining to the document associated with the selected entry, and a hyperlink to the document." The Examiner alleges that the list of e-mails in Fig. 3 of Outlook is the equivalent of the claimed reusable list, but this position is incorrect for at least the reason that the list in Fig. 3 of Outlook appears to comprise a user Inbox including a list of e-mails. Even if the teachings of Barnes were combined with Outlook, at best, this would teach cutting and pasting a copy of the original e-mail, rather than pasting a hyperlink to the original e-mail itself.

In fact, the Examiner expressly acknowledges that the copying described in Barnes teaches "copying data without disturbing the original documents. This provides the benefit of protecting, and preserving the original files." See Final Action at 4. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for at least the

reason that the combination of Huang, Outlook, and Barnes teaches creating a copy of an e-mail or document, whereas claim 1 explicitly provides that each entry in the reusable list "includes. . . a hyperlink to the document associated with the selected entry, not a copy of the document." Thus, in the combination relied upon by the Examiner, any changes made to a document or e-mail would not be reflected in the copy. The Examiner acknowledges this difference in numerous independent instances by conceding that the copying/pasting in the combination of Huang, Outlook, and Barnes leaves the original documents undisturbed. See Final Action at p. 4, lines 12-15; p. 5, lines 7-11; p. 5, lines 16-21; and p. 7, lines 15-20. In contrast, claim 1 recites "in response to the user selecting a hyperlink from the reusable list, displaying a current version of a document associated with the hyperlink, including any changes made to the document subsequent to creating the reusable list." Thus, to view the document, a user follows a hyperlink to the original document. That is, the entries in the reusable list contain links to the original document, and any changes made to the document are reflected in the original summary view as well as in the reusable list, as the reusable list includes a "hyperlink to the document associated with the selected entry, not a copy."

In the previous response, Applicant similarly argued that the references relied upon by the Examiner appear to relate to creating copies of selected documents, not hyperlinks to the selected documents themselves. In response, the Examiner alleges that the combination of references teach the "user views the email messages themselves by clicking on one of the message information." See Final Action at 9. The Examiner's position fails to demonstrate that the combination teaches a hyperlink to the original document for at least the reason that the email messages identified by the Examiner are not analogous to the claimed entries in a reusable list. The Examiner relies upon the screenshots of Outlook, which merely demonstrate that by selecting an email, a user can open the email. This alleged teaching fails to establish that claim 1 is obvious for at least the reasons that: (1) an email is not a hyperlink to a document; and (2) the screenshots provided by the Examiner are of an Inbox, not a copy of selected emails in an Inbox.

At various points in the rejection, the Examiner alleges that an Outlook Inbox teaches a reusable list of entries, including summary data and a hyperlink to the document associated with an entry. However, the screenshots provided are of an original Inbox, not a list of entries including a hyperlink to an original document. Moreover, the Examiner's motivation to combine references alleges principles of protecting original documents against changes made in a copy, which is contrary to several claim features, such as "displaying a current version of a document, including any changes made to a document subsequent to creating the reusable list." For at least the foregoing reasons, the rejection is improper and should be withdrawn.

Independent claims 8, 15, and 23-24 contain similar features as discussed above for claim 1. Therefore, the rejection of these claims is likewise improper for at least the same reasons presented above with regard to claim 1. Dependent claims 2-7, 9-14, 16-22, and 25 are allowable at least because they depend from allowable independent claims, as well as for the further limitations they contain.

CONCLUSION


Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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Respectfully submitted,

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